

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/593,316
Filing Date	June 13, 2000
First Named Inventor	John Clark, et al.
Art Unit	1632
Examiner Name	Quan J. Li
Attorney Docket Number	730/002
Total Number of Pages in This Submission	24

RECEIVED
APR 07 2003
TECH CENTER 1800

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form (in duplicate) <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply (11 pages) <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (2 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request to Vacate Finality of Office Action as Premature Pursuant to 37 CFR 1.104(b) and 1.113 (b) and MPEP 706.07(d) (3 pages), PTO Form 1449 (2 pages) + (1) reference, postcard
Remarks _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	J. Michael Schiff, Registration No. 40,253
Signature	<i>J. Michael Schiff</i>
Date	March 31, 2003

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: March 31, 2003			
Typed or printed	MICHAEL SCHIFF		
Signature	<i>J. Michael Schiff</i>	Date	March 31, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

APR 04 2003

PTO/SB/17 (01-03)

Approved for use through 04/30/2003. OMB 0651-0032

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 180.00

Complete if Known

Application Number	09/593,316
Filing Date	June 13, 2000
First Named Inventor	John Clark, et al.
Examiner Name	Quan J. Li
Art Unit	1632
Attorney Docket No.	730/002

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:Deposit Account Number
Deposit Account Name

07-1139

Geron Corporation

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 750	2001 375	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 520	2003 260	Plant filing fee	
1004 750	2004 375	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 84	2201 42	Independent claims in excess of 3	
1203 280	2203 140	Multiple dependent claim, if not paid	
1204 84	2204 42	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 410	2252 205	Extension for reply within second month	
1253 930	2253 465	Extension for reply within third month	
1254 1,450	2254 725	Extension for reply within fourth month	
1255 1,970	2255 985	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,300	2453 650	Petition to revive - unintentional	
1501 1,300	2501 650	Utility issue fee (or reissue)	
1502 470	2502 235	Design issue fee	
1503 630	2503 315	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	180.00
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.129(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 180.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)

J. Michael Schiff

Registration No
(Attorney/Agent)

40,253

Telephone

(650) 473-7715

Signature

Date

June 31, 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2



CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents & Trademarks, Washington, D.C. 20231, on the date indicated.

Name

Date

March 31, 2003

TECH CENTER 1600/2900

APR 07 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: J. Clark & C. Denning

Art Unit: 1632

Filing Date: June 13, 2000

Examiner: Quan J. Li, Ph.D.

Serial No: 09/593,316

Docket: 730/002

Title: ANIMAL TISSUE FOR
XENOTRANSPLANTATION

**REQUEST TO VACATE FINALITY OF OFFICE ACTION AS PREMATURE
PURSUANT TO**

37 CFR §§ 1.104(b) AND 1.113(b), AND MPEP § 706.07(d)

Commissioner for Patents and Trademarks
Washington, D.C. 20231

Dear Sir,

Applicant hereby requests that the Examiner vacate finality of the Office Action dated January 30, 2003 (Paper No. 17).

This is not a Petition under 37 CFR § 1.181, or a Request for Continued Examination under 37 CFR § 1.114. Applicant requests that the finality be vacated pursuant to MPEP § 706.07(c) and (d), on the basis that the finality is premature.

Claims 1-6, 13-15, and 33-37 are under examination. The claims all stand rejected under 35 USC § 112 ¶ 1, on the allegation that homozygous knockout sheep devoid of Gal α (1,3)Gal determinants are not described or enabled by the specification.

Claims 4, 5, and 33-37 do not require that knockout sheep be made. These claims require only that a single cell be produced in which one or both of the α (1,3)galactosyltransferase alleles have been inactivated. The making of knockout cells is described throughout the specification.


Reduction to practice is illustrated in the specification in Examples 4 and 5 (page 50-52), in which α 1,3GT knockout fibroblasts were actually made. This was explained in the responses already filed in this application on March 19, 2002, and November 18, 2002. Accordingly, the rejection of claims 4, 5, and 33-37 are believed to be overcome.

However, rejection of claims 4, 5, and 33-37 was maintained in the Office Action dated January 30, 2003. *The Office Action does not provide an explanation* as to why the cells covered by these claims are not described and enabled by the specification as filed. Specifically, Action does not explain why the asserted inability to make knockout sheep prevents the making of these cells, since the cells can be made by other means — specifically, cells bearing an inactivated α 1,3GT allele can be made in vitro using the methods and materials illustrated in Examples 4 and 5. The enablement requirement is met if the description enables *any mode* of making and using the claimed invention. *Engel Industries, Inc. v. Lockformer Co.*, 20 USPQ2d 1300 (Fed. Cir. 1991).

Accordingly, Examiner's Action is not complete, as required by 37 CFR § 1.104(b). The Action does not state the grounds for rejection of claims 4, 5, and 33-37, as required by 37 CFR § 1.113(b). Since finality of the rejection is not adequately supported, it is premature.

As a remedy, applicant respectfully requests that the application be allowed, in view of the remarks made in the Response to the Office Action enclosed herewith. In the alternative, should the Office determine that not all claims in the application are in condition for allowance, applicant requests that the finality of the last Office Action be vacated, pursuant to MPEP § 706.07(d). Applicant further requests that a new Office Action be issued, indicating that claims 4, 5, and 33-37 are allowed, or why the Office considers them to be unpatentable.

Respectfully submitted,



J. Michael Schiff
Registration No. 40,253

GERON CORPORATION
230 Constitution Drive
Menlo Park, CA 94025
Telephone: (650) 473-7715
Fax: (650) 473-8654

March 31, 2003